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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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03/31/2004

Hermann Lueckhoff

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EXAMINER

SHAW, PELING ANDY

ART UNIT

PAPER NUMBER

2444

NOTIFICATION DATE

DELIVERY MODE

10/16/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/814,832	<b>Applicant(s)</b> LUECKHOFF, HERMANN	
	<b>Examiner</b> PELING A. SHAW	<b>Art Unit</b> 2444	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Restriction election***

1. Amendment received on 07/16/2008 has been entered into record. The Office acknowledges the receipt of Applicant's restriction election. Applicant elects Group a, claims 1-10, 11-14 and 15-22, without traverse. Claims 23-24 are cancelled. Claims 1-10, 11-14 and 15-22 are currently pending.

### ***Priority***

2. This application has no priority claim made. The filing date is 03/31/2004.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-14 and 15-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

- a. Claims 11 and 15 recites the limitation of "computer program product". That is software per se. Further more as per lines 15-29 on page 19 of applicant's specification, a computer program product can be embodied in an information carrier, e.g. in a propagated signal. That is an evidence of that the invention is intended to be beyond the scope under 35 U.S.C. 101, i.e. process, machine, manufacture, or composition of matter. Thus claims 11, 15 and their dependent claims 12-14 and 16-22 are rejected. For the purpose of applying art, the limitation of "computer program product" is read as "computer program stored in a machine-readable storage device" as per lines 15-29 on page 19 of applicant's specification.

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Appropriate corrections are required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-9, 11-17, 19-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Arora et al. (US 20040064512 A1), hereinafter referred as Arora.

- a. Regarding claim 1, Arora disclosed a method for use in a computer system for responding to received electronic messages, the method comprising: upon receipt of an incoming electronic message in a computer system (paragraph 18: join an instant message group), accessing meta information stored in the computer system that identifies a first pre-selected class of a plurality of classes of stored fact information (paragraph 80: join the network, query and index registered keywords and subjects of interest, registered metadata); retrieving a portion of the stored fact information that is a member of the first pre-selected class (paragraph 86: membership service); and storing the retrieved portion of the stored fact information in an electronic file that is associated with the incoming electronic message such that a rule for processing the

- incoming electronic message can be applied to the retrieved portion (paragraph 129: share a common set of interests and rules to publish, share and access contents)..
- b. Regarding claim 2, Arora disclosed the method of claim 1, wherein the portion of the stored fact information is retrieved when there is a need to apply the rule (paragraph 719: rule by which security is enforced).
  - c. Regarding claim 3, Arora disclosed the method of claim 1, wherein the computer system includes a workflow for processing the incoming electronic message and wherein the method further comprises providing the electronic file with a lifetime bound to the workflow (paragraph 596: rendezvous service, query propagation within the limits of loop and TTL).
  - d. Regarding claim 5, Arora disclosed the method of claim 1, wherein the meta information includes the rule and a fact attribute identified by the rule, the fact attribute identifying the first pre-selected class of stored fact information, and wherein accessing the meta information comprises accessing the rule and the fact attribute (paragraph 129: share a common set of interests and rules to publish, share and access contents; paragraph 719: rule by which security is enforced).
  - e. Regarding claim 6, Arora disclosed the method of claim 5, further comprising performing an initial screening of the incoming electronic message before accessing the meta information, wherein a result of the initial screening is used to select the rule from a plurality of rules (paragraph 129: share a common set of interests and rules to publish, share and access contents; paragraph 481: membership screening).

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- f. Regarding claim 7, Arora disclosed the method of claim 5, wherein the meta information further includes an identifier specifying where the retrieved portion of stored fact information is to be stored in the electronic file, and wherein the identifier is used in storing the retrieved portion (paragraph 16: store a zone of instant messaging distributed index, instant messaging information for a subset of the peers at locations in the zone indicated by hashes of identifiers of the peers in the instant messaging group).
- g. Regarding claim 8, Arora disclosed the method of claim 7, further comprising using the identifier to access the retrieved portion of stored fact information in the electronic file to apply the rule to the retrieved portion (paragraph 129: share a common set of interests and rules to publish, share and access contents; paragraph 719: rule by which security is enforced).
- h. Regarding claim 9, Arora disclosed the method of claim 7, wherein the identifier is an XPath query (paragraph 11, XPath for locate and process items in XML; paragraph 64: XPath query for XML).
- i. Claims 11-14 are of the same scope as claims 1-3 and 5-6. These are rejected for the same reasons as for claims 1-3 and 5-6.
- j. Claims 15-17 and 19-22 are of the same scope as claims 1-3, 5 and 7-9. These are rejected for the same reasons as for claims 1-3, 5 and 7-9.

Arora disclosed all limitations of claims 1-3, 5-9, 11-17, 19-22. Claims 1-3, 5-9, 11-17, 19-22 are rejected under 35 U.S.C. 102(e).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arora as applied to claim 1 above, and further in view of Chandra et al. (US 7130885 B2), hereinafter referred as Chandra.

- a. Regarding claim 4, Arora disclosed the invention substantially as claimed. Arora does not explicitly disclose wherein the electronic file is an XML document and the retrieved portion is stored in the XML document using an XSL transaction. However, Arora does show (paragraph 662) using XML to send message of different types.
- b. Chandra shows (Fig. 18E and column 71, lines 38-51) that XSL style sheet is used to generate XML) in an analogous art for the purpose of providing electronic messages that are linked and aggregated.
- c. It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify Arora's functions of instant messaging using distributed indexes with Chandra's functions of using XSL to generate XML.
- d. The modification would have been obvious because one of ordinary skill in the art would have been motivated to further detail how XML would be implemented in the electronic messaging system as per Chandra in the general art of using XML in

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messaging as per Arora (paragraph 347) and Chandra (column 67, lines 36-53)'s teaching.

- e. Regarding claim 10, Chandra shows wherein the retrieved portion of the stored fact information pertains to at least one category selected from the group consisting of: a business context of the incoming electronic message, analytical data relating to the incoming electronic message, availability of a person for attending to the incoming electronic message, a skill of a person for attending to the incoming electronic message, communication information relating to the incoming electronic message, an industry with which the incoming electronic message is associated, and combinations thereof (Fig. 12 and 13D; column 54, lines 23-43; invitation to meet; column 55, lines 57-67: schedule for availability).
- f. Claim 18 is of the same scope as claim 4. It is rejected for the same reasons as for claim 4.

Together Arora and Chandra disclosed all limitations of claims 4, 10 and 18. Claims 4, 10 and 18 are rejected under 35 U.S.C. 103(a).



***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to the enclosed PTO-892 for details.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peling A. Shaw whose telephone number is (571) 272-7968. The examiner can normally be reached on M-F 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Peling A Shaw/  
Examiner, Art Unit 2444